REMARKS

1. Restriction Requirement

In the Office Action mailed December 13, 2007, the Office restricted the subject matter of the present application into 2 groups:

I. Claims 1-14, drawn to a polymerizable resin material comprising a photoinitiator, classified in class 522, subclass 182.

II. Claims 15-34, drawn to a method for making a plastic lens comprising curing a lens composition in a mold, classified in class 264, subclass 496.

Applicant hereby confirms the election of group I, claims 1-14. Applicant submits that the process claims 15-34 require all of the limitations of the product claims 1-14, and therefore should be eligible for rejoinder upon a finding of allowability of the product claims. See M.P.E.P. § 821.04(b).

2. Amendments to the Specification

Applicant has amended the specification in response to the Examiner's objection.

Applicant has further amended the specification to recite that Irgacure® 1700 is a photoinitiator, not a UV stabilizer. Support for this amendment is found throughout the specification as filed, including in Example 2.

3. Claim Amendments

Applicant has canceled claims 13, 14, 33 and 34 without prejudice.

Applicant has amended claims 1-7, 9-12 to more clearly point out the claimed invention. No new matter is believed to be added by these amendments.

In particular, claims 1, 10 and 12 have been amended to recite that the weight percent values recited therein total to 100%, exclusive of photoinitiator, as is apparent from Examples 1-4.

In particular, claim 4 has been amended to recite that the photoinitiator is not peroxide-based. Support for this amendment is found in the specification at page 11, lines 7-8.

In particular, the weight-percent limitations that were amended in claims 11-12 were drawn from Examples 1-4, in which dye is present at about a 0.004 wt% concentration; and dye stabilizers (silane and the Chromtech PH materials) are present at about a 2.91056 wt% concentration.

In order to simplify rejoinder of the process claims with the product claims, Applicant has similarly amended the claims 15, 16 and 25-32 in group II. These claims are shown in marked-up form, but are noted as being "Withdrawn."

4. Claim Objections

The Examiner has objected to claim 2 because it recited a "monyl phenol" moiety. Claim 2 has been corrected.

The Examiner also noted that the specification recited a "monyl phenol" moiety at page 7, line 20. The specification has been corrected so that the recited nonyl phenol-based compounds match those recited, for example, at page 11, lines 1-5.

Applicant requests that the Examiner withdraw these objections.

5. Claim Rejections - 35 U.S.C. § 112

The Examiner has rejected claims 1, 2 and 9-14 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner asserts that claims 1, 2 and 9-14 are indefinite because they "set forth weight percents but do not set forth what total weight the recited weight percents are based upon."

Examples 2-4 make clear that the weight percent values total to 100%, exclusive of photoinitiator. Claims 1, 10, 12, 30 and 32 have been rewritten to make this explicit. Accordingly, Applicant requests that the Examiner withdraw the rejections under 35 U.S.C. § 112.

6. Claim Rejections - 35 U.S.C. § 103 - Fukushima et al.

The Examiner has rejected claims 1, 2, 4 and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Fukushima et al. (U.S. 5,969,867). The Examiner asserted that "Fukushima et

al teach that [the claimed monomers] are preferred components of the disclosed compositions. Fukushima et al teach that the disclosed compositions can contain as little as 20-30 parts by weight compound of formula I and correspondingly 70-80 parts by weight of a mixture of 10-90 pbw B-1 and 1-50 pbw B-2 monomers. as taught in Example 9, thus suggesting the instantly claimed wt percents."

Claim 1 has been rewritten to recite that the resin material consists essentially of ethoxylated (1-4) bisphenol A dimethacrylate, benzylmethacrylate and one or more recited stabilizer monomers, each in a specified compositional range, and a photoinitiator. A person following the teachings of Fukushima would include at least 20% of the sulfur-containing compound of formula I, which would materially alter the claimed composition with respect to the claimed resin material. Accordingly, Fukushima et al. does not teach or suggest to the skilled artisan a resin material according to claim 1.

Claims 2, 4 and 6-8 depend ultimately from claim 1. Accordingly Fukushima et al. likewise does not teach or suggest to the skilled artisan a resin material according to any of these claims.

Applicant therefore requests that the Examiner withdraw the rejections of claims 1, 2, 4 and 6-8 under 35 U.S.C. 103(a) based on Fukushima et al.

7. Claim Rejections - 35 U.S.C. § 103 - Coleman et al. in view of Garrity

The Examiner has rejected claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over Coleman et al. (U.S. 5,708,064) in view of Garrity (U.S. 6,174,464). The Examiner asserted that "[i]t would have been obvious to one skilled in the art at the time of the invention to determine the optimum wt. percents of the different monomers, photochromic dyes and other additives to employ in compositions obtained by the combination of the teachings of Coleman et al and Garrity."

Claim 1 has been rewritten to recite that the resin material consists essentially of ethoxylated (1-4) bisphenol A dimethacrylate, benzylmethacrylate and one or more recited stabilizer monomers, each in a specified compositional range, and a photoinitiator. Applicant has found that the claimed resin material is especially suitable for use in making photochromic lenses

using the methods described in the present application. While mention of the claimed monomers may be found scattered in Coleman et al. and Garrity, their combination does not teach or suggest the composition as recited in claim 1 (i.e., having the recited elements and nothing else that would materially alter the properties of the resin material). Coleman et al. generally teaches heat-curable resin materials which may include a wide variety of monomers. Even if Garrity did suggest to the skilled artisan that benzylmethacrylate could be substituted in the compositions of Coleman et al for the high index monomers disclosed therein, the combination of the two references would still fail to teach a resin material consisting essentially of bisphenol A ethoxylate (1-4) dimethacrylate, a high index monomer such as benzylmethacrylate, one or more of the recited stabilizing monomers and a photoinitiator in the particular compositional ranges recited in claim 1.

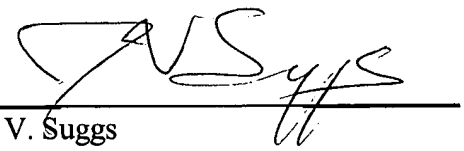
Particular Examples 7 and 8 of Coleman et al. do include ethoxylated bisphenol A dimethacrylate in amounts exceeding 70%, but also include over 20% of a methyl-terminated PEG monomethacrylate; the addition of the PEG-based material in these compositions would make them materially different than the claimed compositions. Similarly, while Garrity may teach (at col. 6-8) a composition including both an ethoxylated bisphenol A dimethacrylate and a monomer (d) which may be, among many other things, benzyl methacrylate, this composition also includes at least 10% of an aromatic monovinyl monomer, which would materially alter the properties of the resin material as recited in claim 1.

Because the combination of Coleman et al. and Garrity does not teach or suggest a resin material consisting essentially of the components recited in claim 1, it does not render claim 1 unpatentable. Claims 2-9 depend from claim 1, and are believed to be patentable over the combination of Coleman et al. and Garrity for at least the same reasons. Applicant therefore requests that the Examiner withdraw the rejections of claims 1-9 under 35 U.S.C. 103(a) based on Coleman et al. and Garrity.

Please direct any questions or comments to the undersigned at the telephone number provided below.

Respectfully submitted,

McDonnell Boehnen Hulbert & Berghoff LLP

Date: March 13, 2007 By: 

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